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PATENT

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Attorney Ref.: IND-106

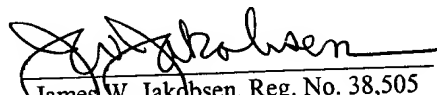# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:	)	
	)	
Denis KHOO, et al.	)	Examiner: (To Be Assigned)
	)	
Serial No.: 09/849,495	)	Group Art Unit: 2162
	)	
Filed: May 4, 2001	)	
	)	
For: **METHOD AND SYSTEM FOR**	)	
PROVIDING CONTENT WITH	)	
AN OPTION	)	

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GROUP 3600

Commissioner of Patents
Washington, D.C. 20231

PETITION TO MAKE SPECIAL UNDER 37 C.F.R. § 1.102(d)

Dear Sir/Madam:

Applicants hereby petition pursuant to M.P.E.P. § 708.02(VIII) to make the above-identified patent application special. If it is determined that the pending claims are not directed to a single invention, Applicants will make an election without traverse as required under M.P.E.P. § 708.02(VIII)(B). The petition fee as set forth in 37 C.F.R. § 1.17(h) is filed herewith. The Commissioner is authorized to charge any additional fees required or credit any overpayments to Deposit Account No. 03-3975. A copy of this petition is included for this purpose.

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I. CITATION OF REFERENCES

Applicants submit that a pre-examination search for prior art deemed most closely related to the subject matter encompassed by the pending claims was made by a professional searcher in the following classes/subclasses:

Class 725, subclasses 5, 8, 9, 32, 34, and 35.

A list of patents found during the pre-examination search, patents cited in related patent application no. 09/487,120, which is now issued as U.S. Patent No. 6,434,747, patents cited in a related International Search Report are provided below, and patents filed in an Information Disclosure Statement filed on July 25, 2001 is provided below.

U.S. PATENT/APPLICATION NO.	INVENTOR(S)
2001/0003845[1]	Tsukamoto, et al.
4,789,863[4]	Bush
4,947,429[4]	Bestler, et al.
5,367,330[4]	Haave, et al.
5,459,506[4]	Bushnell
5,479,508[4]	Bestler, at al.
5,532,735[1]	Blahut, et al.
5,621,456[2]	Florin, et al.
5,745,710[2]	Clanton, et al.
5,758,259[2,3]	Lawler
5,838,314[1]	Neel, et al.
5,848,396[2,3]	Gerace
5,848,397[2,3]	Marsh, et al.
5,861,881[2]	Freeman, et al.

6,012,080[4]	Ozden, et al.
6,088,722[2]	Herz, et al.
6,177,931[2,3]	Alexander, et al.
6,211,901[2]	Imajima, et al.

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[1] Patent found during the pre-examination search.

[2] Patent cited in related patent application no. 09/487,120, which is now issued as U.S. Patent No. 6,434,747.

[3] Patent cited in an International Search Report of related international patent application no. PCT/US01/01115. The Search Report is also enclosed for Examiner's review.

[4] patents filed in an Information Disclosure Statement filed on July 25, 2001.

Enclosed herewith are an Information Disclosure Statement including Form PTO-1449 citing the patents found during the pre-examination search, cited in related patent application no. 09/487,120, cited in the International Search Report of related international patent application no. PCT/US01/01115, and a copy of each reference cited in the Form PTO-1449.

II.   DETAILED DISCUSSION OF THE REFERENCES

U.S. Patent Application Publication No. 2001/0003845 to Tsukamoto, et al.

Tsukamoto, et al. ("Tsukamoto") discloses a television broadcasting system having an automated charging system. In the system each viewer on the subscriber side of the cable television broadcasting system selects, before viewing a chargeable program, one of the two options including a first option wherein the viewer views the chargeable programs without viewing the advertisement programs and a second option wherein the viewer views the advertisement programs in addition to the chargeable program. If the viewer selects the first option, the broadcasting system sets a first charging system which charges a highest fee. On the other hand, if the viewer selects the second option, the broadcasting system sets a second charging system.

U.S. Patent No. 4,789,863 to Bush

Bush discloses a pay-per-view entertainment system for distributing prerecorded entertainment to the consuming public. The system includes a source of prerecorded entertainment that is in the form of complete music works and highlighted selections or previews of these complete musical works. The source uses compact disc mastering equipment or cart duplication equipment to make the prerecorded musical entertainment available to an operator. The operator possesses playback equipment that is connected to a network of coaxial cable. The coaxial cable connects the operator to each individual subscriber. Each individual subscriber possesses a receiver which is capable of receiving the previews of the complete musical works. If the subscriber is desirous of making a recording of the complete musical work, he enters data into a keyboard and the receiver records the desired selection. The service charge associated with the recording of the selected musical work is automatically charged to the subscriber.

U.S. Patent No. 4,947,429 to Bestler, et al.

Bestler, et al. ("Bestler") disclose a pay-per-view television signaling method. A system supporting the method may include a head end and a plurality of subscriber terminals, each terminal having an authorization memory that has a plurality of memory locations for storing authorization data received from the head end, and a device for unscrambling a received television program in response to authorization data stored in a memory location identified by a simultaneously received program tag. The method may include the steps of transmitting, from the head end, a pay per view tag identifying a memory location of the authorization memory corresponding to a selected pay per view television program; enabling subscribers to directly input authorization data to the memory location; and transmitting the pay per view television program with a program tag identifying the memory location.

U.S. Patent No. 5,367,330 to Haave, et al.

Haave, et al. ("Haave") disclose a system and method of controlling and delivering programming to a television transmission substation from a control station, wherein the substation transmits television programming in a scrambled form on one or more channels and a

program schedule on a separate barker channel over a multi-channel cable or over-the-air distribution system to all of a plurality of remote subscriber receiving locations on a pay-per-view basis.

The method may include the steps of transmitting television programming from the control station for reception on receiving means at the substation; recording the television programming on one or more audio video record and playback means at the substation; generating record schedule information on a first computer means at the control station; generating playback schedule information on the first computer means at the control station; transmitting data signals indicative of the record and playback schedule information and of the playback schedule from the control station to a second computer means at the substation; controlling the record and playback of the audio video record and playback means at the substation in accordance with the record and playback schedule information transmitted from the control station; transmitting information indicative of the playback schedule in the form of one or both of text and graphics from the substation to the subscriber receiving locations on the separate barker channel; and selectively enabling descrambling of the television programming from the substation to individual subscriber receiving locations in response to a request from the individual subscribers for a particular television program on a pay-per-view basis.

In accordance with the invention, a pay-per-view television system is provided wherein programming can be originated and scheduled by a network control station for a multiplicity of affiliated substations. The network station is able to supply different programming to different affiliate substations, who themselves may be offering a different number of channels of pay-per-view programming. The network station is able to change the programming schedule on a weekly or other basis and use a different playback schedule for each affiliate substation, one that is most likely to generate the highest possible rates. Up to the minute information on buy rates or programming recommendations can be sent from each affiliate to the network, allowing the network to consider programming scheduling changes.

U.S. Patent No. 5,459,506 to Bushnell

Bushnell discloses a pay-per-view system which includes a conductor that carries M different pay-per-view programs. The pay-per-view system also includes a device that allows

pay-per-view subscribers to select a maximum of N different pay-per-view programs from the M different pay-per-view programs, where N is the number of pay-per-view channels available to the subscribers and N is less than M. The pay-per-view system further includes a device for communicating to each respective television set of each of the pay-per-view subscribers a respective pay-per-view program which the subscriber selected. To bill each pay-per-view subscriber, the pay-per-view system also has a device for billing subscribers for the pay-per-view program which the subscriber selected. To prevent viewing by non-pay-per-view cable television subscribers, each program communicated is scrambled and only the pay-per-view subscribers have messages transmitted to their set top boxes enabling their descramblers.

U.S. Patent No. 5,479,508 to Bestler, at al.

Bestler, et al. ("Bestler") discloses a method of operating a cable system having premium channel encoders and dedicated smart pay-per-view encoders, each associated with an individual channel. The pay-per-view encoders are provided with the addresses of certain subscriber stations that have been approved to decode pay-per-view events on the associated channels. These certain subscriber stations are addressed on a priority basis by the pay-per-view encoder handling the pay-per-view event to set their authorization memories to decode the pay-per-view event. The authorization memories are updated by RAM groups of five program tags. All of the pay-per-view encoders are assigned to the same RAM group so that in updating authorization memories, the authorization of a subscriber station memory for another pay-per-view event is not altered. The authorization process is rapidly accomplished and is repeated for a period of time after commencement of the pay-per-view event. The certain subscriber stations are immediately deauthorized by the same pay-per-view encoder at the end of the pay-per-view event.

U.S. Patent No. 5,532,735 to Blahut, et al.

Blahut, et al. ("Blahut") discloses a method of advertisement selection for an interactive service. In the system a provider of interactive services may have three basic monthly rates. A first rate would be charged to those accounts indicating a desire for no advertisements, regardless of whether they are requesting a sporting event, a re-run of a situation comedy, the news, etc. A second rate would be charged to those accounts indicating a desire to view a minimal amount of

advertisements. A third rate would be charged to those accounts indicating a desire to watch a more than minimal amount of advertisements. The rate could be adjusted up or down if a viewer at the interactive services subscriber location indicates that for a particular show or time frame, an amount of advertisements different than the "default" monthly amount is desired. The charge to the account could, for example, be adjusted on a pro-rata bases between, e.g., the first rate and the second rate. Thus, a requested show need not be limited to a video on demand but may include simply turning on one's TV to a sporting event, a re-run of a situation comedy, the news, etc.

U.S. Patent No. 5,621,456 to Florin, et al.

Florin, et al. ("Florin") disclose a method and apparatus using an audio-visual interface for the display of multiple program categories. An interactive audio-visual (A/V) transceiver is coupled to a television or telephone (T/T) cable, a TV, a video recorder (VCR), and other A/V devices. The A/V transceiver switches data between a program/service provider and the connected A/V devices. A remote control device is provided for communicating with the transceiver, and includes a number of user selectable interactive functions such as: an info button, a list button, a categories button, a pix button, a mark button, a jump button, a select button, and a pointing device (up, down, left, and right arrow buttons).

While viewing the TV, a user may obtain additional information on a current program by depressing the info button, and obtaining more detailed information using the pointing device. By depressing the list button, the transceiver displays a program listing of the current programs available for viewing. Through the use of the pointing device, viewers can scroll up and down the program listing or view a highlighted program in full screen by pressing the select button. By pushing the right or left arrow buttons on the pointing device, program listings may also be viewed for different hours, days and up to several weeks in advance. The depression of the categories button results in the display of a categories menu bar on the TV screen, which includes categories such as "all," "sports," "news," and "favorites". The depression of the pix button results in the display of a "visual menu" of multiple picture-in-picture (PIP) windows along the perimeter of the TV screen. Depression of the mark button allows users to

"bookmark" a particular program for later viewing and depression of the jump button allows a user to jump between previously marked programs.

U.S. Patent No. 5,745,710 to Clanton, et al.

Clanton, et al. ("Clanton ") disclose a graphical user interface for displaying and selecting video programs, such as video on demand, and includes a video on demand server coupled to a communication medium. A plurality of set-top box receivers are coupled to the communication medium for receiving digitized programming in the form of movies and the like from the video on demand server. The set-top box includes a central processing unit (CPU) coupled to a memory and other electronic modules. The CPU generates and displays a graphical user interface on the subscriber's television (TV). The graphical user interface is based upon a metaphor in which a world of spaces are organized as part of a studio back lot through which a user may navigate. The back lot includes a poster wall which presents to the user a series of movie posters representing available selections. When a user touches a poster on a touch sensitive screen of the TV, the CPU generates an animation which displays the poster coming off of the wall and appearing in the foreground of the screen. If a subscriber selects the poster to view a feature presentation, the video on the demand server downloads the selected video which is displayed on the TV.

U.S. Patent No. 5,758,259 to Lawler

Lawler discloses an automated selective programming guide for identifying for a selected viewer a preferred program available from an interactive television or televideo (IT) system at a selected time. The preferred program and criteria for identifying the preferred program are selected automatically. As a result, the method of identifying the preferred programming is transparent to, and requires no explicit selection by, the viewer. In operation, the IT system identifies particular characteristics of programming delivered to the selected viewer. With reference to a motion picture, for example, the particular characteristics could include the names of the director, leading actors, and the genre of the motion picture. The IT system establishes for each viewer a database or table of viewer preferences representing the particular characteristics of programming previously delivered (i.e., a viewing history for the viewer). Whenever a viewer

requests a listing of preferred programming for a selected time, the IT system compares the particular characteristics in the viewer preference table to the predetermined characteristics of programming available at the selected time. The IT system determines for the programming available at the selected time degrees of correlation to the predetermined characteristics in the viewer preference table. The programming available at the selected time having the greatest degree of correlation is identified as the preferred program.

U.S. Patent No. 5,838,314 to Neel, et al.

Neel, et al. ("Neel") disclose a system that can be configured so that a system user receives a different advertisement each time he or she selects to have the advertiser pay for a video-on-demand movie. The data base stores in the customer's file which advertisements previously have been viewed. Likewise, the system can control the type of advertisement that is selected for a given customer; e.g., the system will select and transmit advertisements for recreational vehicles to users who choose adventure video entertainment; customers who watch classic video entertainment will receive advertisements for luxury vehicles. In addition, customers can interact with the system and choose advertisements for the products that interest them.

U.S. Patent No. 5,848,396 to Gerace

Gerace discloses a method and apparatus for determining a behavioral profile of a computer user. The invention uses "agate" information to determine the profile of a computer user and, in particular, the behavioral or psychographic profile, as distinguished from the demographic profile, of a user. The term agate is used to refer to time-sensitive, reference information that is not read linearly. Examples are telephone listings, classified ads, weather reports, sports scores and statistics, market data, books and recordings in print, and television and film listings. To determine the profile of a computer user, the invention provides (i) a data assembly for displaying customized agate information to a computer user, and (ii) a tracking and profiling member for recording user activity with respect to agate information displayed through the data assembly. Over time, the tracking and profiling member holds a history and/or pattern of user activity which in turn is interpreted as a user's habits and/or preferences. To that end, a

psychographic profile is inferred from the recorded activities in the tracking and profiling member.

U.S. Patent No. 5,848,397 to Marsh, et al.

Marsh, et al. ("Marsh") disclose a method for scheduling the presentation of messages to computer users. An advertisement display scheduler resident on a user's computer receives advertisements from a server system over a network. Upon receipt, the advertisement display scheduler determines the priority of the advertisement and assigns it to one of a plurality of prioritized advertisement queues. Each queue is sorted according to predetermined scheduling criteria so that advertisements deemed "more important" are presented to a user first. The advertisement display scheduler logs statistical information relating to the presentation of advertisements for use in updating the scheduling criteria, and makes such statistical information available to the server system.

U.S. Patent No. 5,861,881 to Freeman, et al.

Freeman, et al. ("Freeman") disclose an interactive computer system which may operate on a computer network. Subscribers interact with a fully interactive program through the use of input devices and a personal computer or a television. The multiple video/audio data streams may be received from a broadcast transmission source or may be resident in local or external storage. In response to user inputs, a personalized graphics, video and/or audio presentation is provided to the user either immediately or at a later time. If not presented immediately, the interactive computer system utilizes "trigger points" to determine when to enable multiple multimedia segments during the show. The CPU uses embedded or stored authoring commands for integrating the various multimedia elements. The interactive multimedia computer enables flicker-free switching from one signal to another on the same or different channels.

U.S. Patent No. 6,012,080 to Ozden, et al.

Ozden, et al. ("Ozden") disclose a method and apparatus for providing enhanced pay-per-view in a video server. Specifically, the invention periodically schedules a group of non-preemptible tasks corresponding to videos in a video server having a predetermined number of

processors, wherein each task is defined by a computation time and a period. To schedule the group of tasks, the present invention divides the tasks into two groups according to whether they may be scheduled on less than one processor. The present invention schedules each group separately. For the group of tasks schedulable on less than one processor, the present invention conducts a first determination of schedulability. If the first determination of schedulability deems the group of tasks not schedulable, then the present invention conducts a second determination of schedulability. If the second determination of schedulability also deems the group of tasks not schedulable, then the present invention recursively partitions the group of tasks in subsets and re-performs the second determination of schedulability. Recursive partitioning continues until the group of tasks is deemed schedulable or no longer partitionable. In the latter case, the group of tasks is deemed not schedulable.

U.S. Patent No. 6,088,722 to Herz, et al.

Herz, et al. ("Herz") disclose a system and method for scheduling the receipt of desired movies and other forms of data from a network, which simultaneously distributes many sources of such data to many customers, as in a cable television system. Customer profiles are developed for the recipient describing how important certain characteristics of the broadcast video program, movie, or other data are to each customer. From these profiles, an "agreement matrix" is calculated by comparing the recipient's profiles to the actual profiles of the characteristics of the available video programs, movies, or other data. The agreement matrix thus characterizes the attractiveness of each video program, movie, or other data to each prospective customer. "Virtual" channels are generated from the agreement matrix to produce a series of video or data programming which will provide the greatest satisfaction to each customer. Feedback paths are also provided so that the customer's profiles and/or the profiles of the video programs or other data may be modified to reflect actual usage, and so that the data downloaded to the customer's set top terminal may be minimized.

U.S. Patent No. 6,177,931 to Alexander, et al.

Alexander, et al. ("Alexander") disclose an embodiment of an interactive television system including a means for receiving a television signal that carries a plurality of channels of

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video programs and a display for displaying the video programs, graphics and other viewable information. The system further includes a means for selecting one of the channels carried by the television signal for display of a video program on the display monitor. Multiple types of data are stored and accessible from a memory, including a data base of television scheduling data and a data base of advertising information. A means is provided for collecting viewer profile data and for selecting a portion of the advertising information based on the view profile data. A means is further provided for simultaneously formatting and displaying the television video program, the television scheduling data as an on screen electronic television program guide, and the selected portion of the advertising information on the display monitor. One of the displayed program titles from display of the on screen electronic television program guide may be selected for display on the display monitor.

U.S. Patent No. 6,211,901 to Imajima, et al.

Imajima, et al. ("Imajima") disclose a video data distributing device by video on demand (VOD), wherein a requested title recognizing mechanism recognizes the title of a video requested by a subscriber. A VOD service state monitoring mechanism determines whether or not the broadcast of the video is to be provided in the full video on demand (FVOD) or the near video on demand (NVOD) service, and if there is any available channel for the broadcast. If the broadcast has not been switched from the FVOD service to the NVOD service, then a busy state monitoring mechanism checks the number of the current simultaneous subscribers for the video. If the number is equal to or larger than a threshold, then the busy state monitoring mechanism instructs an NVOD service providing mechanism to broadcast the requested video in the NVOD service. If the number is smaller than the threshold, then the busy state monitoring mechanism instructs an FVOD service providing mechanism to broadcast the requested video in the FVOD service.

III.   DISCLOSURE IN THE KHOO APPLICATION

The Khoo application discloses a method and system for providing content with an option. In one embodiment a method is disclosed for providing content from a content provider to a viewer over a data network where the content is being associated with an option. The

method offers to the viewer an option where the option is a choice between a first choice, of viewing the content without an advertisement being displayed during the content by making a choice compensation to the content provider, and a second choice of viewing the content with the advertisement being displayed during the content by not making the choice compensation to the content provider from the viewer. The viewer selects the first choice or the second choice and communicates the option selected to the content provider. Then the content is provided by the content provider to the viewer based on the option selected. In another embodiment a listener is offered a similar option for listening to content with or without advertisements. Any embodiment described that pertains to viewers applies similarly to the embodiment that pertains to listeners.

The content provider may be any entity that distributes content, such as advertisements, movies, sporting events, situation comedies, drama series, miniseries or the like. The content includes both motion picture content or static content. The content provider would typically have some type of content providing server that distributes the content from a content storage device to the viewer through the data network. When the first choice is chosen, a choice compensation (e.g., a fee paid to the content provider from the viewer) is made. The choice compensation is typically determined in a variety of manners. In one embodiment, the choice compensation is based on the supply and demand per viewer depending on the demographics of the viewer. In another embodiment, the choice compensation is determined based on the ratings of the content being supplied. In still another embodiment, the choice compensation is based on the viewing habits of the viewer. The second choice permits the viewer to choose to view the content with advertisements. The option, thereby, permits a viewer to choose, on a content-by-content basis, whether or not to view advertisements during the display of content.

Exemplary content display devices include an intelligent (that is, a device that can communicate with a data network) television, personal digital assistant, cellular phone or a computer that is able to receive and display images. Exemplary content playback devices include an intelligent radio, computer, cellular phone, or a personal display device.

IV.   CLAIMS IN THE KHOO APPLICATION

An aspect of the invention disclosed in the Khoo application concerns providing a content from a content provider to a viewer/listener over a data network, the content being associated with an option. Independent Claims 1, 17, 18, 19, 20, 26, 27, and 28 of the application cover various forms (e.g., method, system, computer readable medium, electronic signal) of this aspect of the invention. Dependent Claims 2 – 16, 21 - 25 depend directly or indirectly from Claims 1 and 20, respectively, and cover further details of this aspect of the invention. Representative of this aspect of the invention is method Claim 1, which claims a method which includes the steps of offering to the viewer the option, the option being a choice between (a) a first choice of viewing the content without an advertisement being displayed during the content by making a choice compensation to the content provider from the viewer, and (b) a second choice of viewing the content with the advertisement being displayed during the content by not making the choice compensation to the content provider from the viewer; selecting, by the viewer, the first choice or the second choice; communicating the option selected to the content provider; and providing the content, from the content provider to the viewer, based on the option selected.

V.   DISTINCTIONS BETWEEN THE CLAIMS IN THE KHOO APPLICATION AND THE CITED REFERENCES

Tsukamoto, Bush, Bestler, Haave, Bushnell, Bestler, Blahut, Florin, Clanton, Lawler, Neel, Gerace, Marsh, Freeman, Ozden, Herz, Alexander, and Imajima fail to disclose a method and system for providing content with an option as claimed in independent Claims 1, 17, 18, 19, 20, 26, 27, and 28, and claims that depend therefrom. The independent claims provide for a method including the steps of offering to the viewer the option, the option being a choice between (a) a first choice of viewing the content without an advertisement being displayed during the content by making a choice compensation to the content provider from the viewer, and (b) a second choice of viewing the content with the advertisement being displayed during the content by not making the choice compensation to the content provider from the viewer; selecting, by the viewer, the first choice or the second choice; communicating the option selected to the content provider; and providing the content, from the content provider to the viewer, based

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on the option selected. Therefore, the Khoo application claims subject matter which is not disclosed, taught or suggested by the foregoing references and is patentable in light thereof.

VI.   CONCLUSION

It is respectfully submitted that this Petition, in conjunction with the attachments and enclosures identified above, are sufficient to comply with the requirements of 37 C.F.R. § 1.102(d) and, more specifically, with the provisions set forth in M.P.E.P. § 708.02(VIII).

Accordingly, Applicants respectfully request that this Petition be granted and that the above-referenced application be advanced out of turn for examination. Applicants further request an early and favorable action on the merits.

Respectfully submitted,
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